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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,757	12/20/2001	Tony Piotrowski	US010628	3946

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EXAMINER

ALAUBAIDI, HAYTHIM J

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/024,757	Applicant(s) PIOTROWSKI, TONY	
	Examiner Haythim J. Alaubaidi	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is a Final Office Action in response to the amendment of August 11, 2004.
2. Claims 1-19 are presented for examination following the amendment of August 11, 2004, of which Claims 1, 7 and 15 are independent.
3. The Examiner acknowledges the new added claims No. 18 and 19.
4. Claim 19, is rejected under 35 U.S.C. 112, first paragraph.
5. Claims 3 and 19, are rejected under 35 U.S.C. 112, second paragraph.
6. Claims 1, 4, 6-7, 9-11, 13-15 and 17, are rejected under 35 U.S.C. 102(e).
7. Claims 2-3, 5, 8, 12, 16 and 18, are rejected under 35 U.S.C. 103(a).

Response to Arguments

8. Applicant's arguments filed in the Amendment of August 11, 2004 have been fully considered but they are not persuasive.
 - a. Applicant argues that Maes does not teach the new added limitation of "created from an input of audio data by a user". The Examiner however respectfully disagrees. Maes teaches "created from an input of audio data by a user" (Figure No. 1, Element No. 16, i.e. conventional telephone).
 - b. Applicant argues that Maes does not teach "purchasing capability being offline". The Examiner would like to bring the Applicant's attention to the 112, first and second paragraphs above, as the Specification does not talk or describe a "purchasing capability", but does talk about a "purchase process"; if this is what

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the Applicant meant, then according to the Specification of the current Application (paragraph [0017]) the purchase process is being conducted by the merchant, which is addressed by Katz (Col 1, Lines 20-41; see also Col 2, Lines 34-54).

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claim 19, is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation language of the claim is being understood as a user requesting a purchase order without using any line connections (face to face with the merchant), which is not in the Specification of the current application.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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12. Regarding claim 3, the phrase "may be" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "may be"), thereby rendering the scope of the claim(s) unascertainable, in other words, the result of the search may or may not be used by the user. See MPEP § 2173.05(d).

13. Claim 19 recites the limitation "wherein the means for purchasing the desired item or service is performed with a purchase request from the user via an offline process". There is insufficient antecedent basis for this limitation in the Specification of the current Application. The current Application Specification indicate that the purchase order or request is being done through an audio (voice) from a user (see paragraphs [0017]-[0019]) using an on-line device. Reading the language of Claim 19, miss leads the Examiner and/or an ordinary skilled in the art that the purchase request is being requested through an offline process (meaning of offline process [0017]). In addition, the limitation language of the claim is being understood as a user requesting a purchase order without using any line connections (face to face with the merchant).

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1, 4, 6-7, 9-11, 13-15 and 17, are rejected under 35 U.S.C. 102(e) as being anticipated by Stephan H. Maes (European Patent Application EP 1 143 679 and Maes hereinafter).

Regarding Claims 1, 7, 9-11, 15 and 17, Maes discloses:

receiving a voice data packet related to a desired item or service; (Figure 1, Elements No. 15, 16, 24, 21, 22 and 23 and corresponding text; see also Col 5, Paragraph [0019])

that has been created from an input of audio data by a user (Figure No. 1, Element No. 16, i.e. conventional telephone);

forming a search request using information from the voice data packet, (Figure No. 3a, Element No. 105 and corresponding text; see also Col 9, Paragraph [0030]; see also Col 2, Paragraphs [0006] and [0007])

the search request including audio information; (Figure No. 1, Element No 15 and 16 and corresponding text; see also Col 7, Paragraph [0024])

searching one or more databases for the desired item or service; (Figure No 1, Elements No. 25 and 26 and corresponding text)

and providing a result of the search to the user (Col 21, Lines 27-31, i.e. search result; see also Figure 3a, Element 107 and corresponding text).

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Regarding Claim 4, Maes discloses searching step includes searching one or more databases over the Internet (Figure No. 1 and corresponding text; see also Col 6, Paragraph [0023]).

Regarding Claim 6, Maes discloses verifying the user's identity using a voice authentication process (Col 21-22, Paragraph [0066]).

Regarding Claim 13, Maes discloses audio-to-text unit, wherein at least a portion of the search request includes electronic text data (Col 6-7, Paragraphs [0023] and [0024]).

Regarding Claim 14, Maes discloses a result indication formatter that formats the search results in a predetermined order (Col 11, Lines 4-12).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 2-3, 5, 8, 12, 16 and 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephan H. Maes (European Patent Application EP 1 143 679 and

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Maes hereinafter) in view of Ronals A. Katz (U.S. Patent No. 6,055,513 and Katz hereinafter).

Regarding Claims 2 and 16, Maes's reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate wherein, the information includes one or more of the following types of information: consumer information, merchandize/service description, merchandize/service source, financial information and shipping information. However Katz discloses merchandize/service description (Katz, Abstract, i.e. determining at least one good, service or item of information; see also Col 2, Lines 3-7; see also Col 24, Lines 4-11). Given the intended broad application of the Maes system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Maes with the teachings of Katz to include an item description to be purchased or to identify the user purchasing the items or goods, one reason would be to complete the purchasing transaction, as identifying the items and/or good would result in completing the purchasing transaction if the voice or audio search request was in regard to purchasing an item or good or a service.

Regarding Claims 3, 8 and 18, Katz discloses completing a purchase transaction in an offline process; an "offline process" as defined by the Specification of the current Application (Paragraph [0017]) is processing the purchase order by the merchant once

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a request was received "not in real time" (Col 1, Lines 20-41; see also Col 2, Lines 34-54)¹

Regarding Claim 5, Maes's reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate wherein the purchase transaction is a credit or debit card transaction. However Katz discloses wherein the purchase transaction is a credit or debit card transaction (Col 9, Lines 22-64). Given the intended broad application of the Maes system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Maes with the teachings of Katz to include credit or debit transactions, one of many reasons would be to increase the system flexibility and maximizing the consumer convenience by allowing the consumer to purchase a good or service using a credit or debit over the Internet instead of mailing cash or other type of checks to the provider of the good or services.

Regarding Claim 12, Maes discloses verifying the user's identity using a voice authentication process (Col 21-22, Paragraph [0066]).

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

¹ Please note that the Applicant's admitted prior art would also read on the limitations of these claims (see paragraph [0002]); in addition, processing an order offline by a merchant is a well known method and is being used well before the filing of the current application.

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Points of Contact

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (703) 305-1950. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any response to this office action should be mailed to:

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at our fax number (703) 872-9306.

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Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6th
Floor Receptionist, Arlington, Virginia. 22202.

Haythim J. Alaubaidi

Patent Examiner
Technology Center 2100
Art Unit 2161
January 18, 2005


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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER